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09/834,059	04/12/2001	Yong Lung Wei	514-039-11	5262

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EXAMINER

FOSTER, JIMMY G

ART UNIT	PAPER NUMBER
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3728

DATE MAILED: 04/01/2003

12

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.  
09/834,059

Applicant(s)  
Wei

Examiner  
Jimmy G. Foster

Art Unit  
3728



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Jan 24, 2003
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-16 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 3-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some\* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_ 6) ☐ Other:

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1. Claim 2 has been canceled, and claims 1 and 3-16 are pending.

2. The original patent has not been surrendered. Applicant is reminded that this reissue application will not be allowed until the original patent is actually surrendered.

3. Claims 1 and 3-16 are finally rejected as being based upon a defective reissue declaration under 35 U.S.C. 251. See 37 CFR 1.175. This reissue has corrected errors which were not addressed in the original declaration.

Receipt of an appropriate supplemental oath/declaration under 37 CFR 1.175(b)(1) will overcome this rejection under 35 U.S.C. 251. An example of acceptable language to be used in the supplemental oath/declaration is as follows:

"Every error in the patent which was corrected in the present reissue application, and is not covered by a prior oath/declaration submitted in this application, arose without any deceptive intention on the part of the applicant."

In accordance with 37 CFR 1.175(b)(1), a supplemental reissue oath/declaration under 37 CFR 1.175(b)(1) must be received before this reissue application can be allowed.

4. The correction to Figures 1-3 of the drawings has been approved. It is noted that Applicant did not propose a correction to Figure 4. Formal drawings are required.

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5. The amendments to the specification, claims and drawings have been reviewed by the examiner, and they have been found not to include any new matter.

6. The amendment of the paragraph beginning on line 66 of column 2 to the specification is informal/inaccurate because the amendment incorrectly duplicates the text, "are then move upwardly and the two ends of the rear side of each the receiving member 15" (see col. 3, lines 7-8 of the patent). It appears that the duplication was inadvertent since Applicant did not underline the second instance of the duplicate text. Applicant is required to submit a corrected/accurate amendment of the paragraph in response to this Office action.

7. The affidavit of Kailash C. Vasudeva filed on January 24, 2003 has been considered by the examiner. It is acknowledged by the examiner that the affidavit states that Mr. Wei was under the obligation to assign his rights to Maxtech at the time of his invention. However, this falls short of stating that the invention of Mr. Wei was under this obligation at the time his invention was made (see 35 U.S.C. 103(c)).

The examiner further acknowledges that the affidavit states that Maxtech is the assignee of the Patent Numbers 5,803,254, 5,887,715, 6,105,767, and 6,105,770. But the affidavit fails to indicate that Maxtech was the assignee (or that the subject matter of the patents were under an obligation of assignment to Maxtech) at the time that the invention of Mr. Wei was made.

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Accordingly, the affidavit is missing a statement or statements which would convey that at the time that the invention of Wei was made, the subject matter of said patent numbers was (in each case) assigned (or under obligation to be assigned) to Maxtech. The affidavit therefore fails to convey common ownership at the time the invention was made and therefore fails to remove the potential of any of the patent numbers as a reference for precluding patentability under 35 U.S.C. 103.

Applicant will note that even if the Vasudeva references become removed as prior art with respect to 35 U.S.C. 103, they are not removed as prior art with respect to 35 U.S.C. 102. See MPEP 2146.

8. Applicant's amendments and the persuasive arguments therewith have overcome the rejection under 35 U.S.C. 112, first paragraph of the last Office action.

9. The amendments to claims 6 and 11 have overcome the rejection of claims 6, 7 and 11 under 35 U.S.C. 112, second paragraph made in the last Office action.

10. Claims 9-16 are finally rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 9 makes no sense, in that it calls for parallel walls to extend toward each other. Parallel things may not converge.

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In addition there is no antecedent basis for each of the actuating member and receiving member in line 6 of claim 9, making it unclear whether these elements constitute positively recited structure or intended use. With the same problem, there is no antecedent basis for the activating member of line 7 of claim 9.

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in  
(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or  
(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

12. Claims 1, 6-10 and 14-16 are finally rejected under 35 U.S.C. 102(e) as being anticipated by Vasudeva (6,105,770). The apparent *effective filing date* of the Wei patent is the actual filing date: April 10, 1998. An *effective reference date* of the Vasudeva patent is at least November 26, 1997 since the patent is a continuation-in-part of the parent application 08/979,879 which itself includes all of the subject matter claimed. In addition, the patent has domestic priority to the

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provisional application 60/054,395, giving the patent an effective reference date of August 8, 1997 for some claimed subject matter. Therefore, the patent to Vasudeva constitutes a patent of another which was filed as an application in the United States before the invention by applicant (Mr Wei) for patent.

The tool box of Vasudeva includes a main box 1 and a lid 2. Receiving members are defined by the pivotable holders 10 and are provided within the interior of said main box. The lid 2 constitutes means pivotally mounted at 3 to the base portion so as to cover the receiving members when in a closed position and provide access to the interior of the base portion and the receiving member when in the open position, as indicated in Figure 5.

The receiving member holding compartment is shown such as in Figure 3 or 5 and may be considered to define a base portion. Depending on the perspective of the viewer, the compartment wall near the hinge 3 may be considered to be either a bottom or a top, with the opposite wall of the compartment (intermediate of the box) being considered to be the other of the bottom or top. The compartment side walls 14 (see col. 3, lines 50-52) define the base portion side walls. The wall opposite the opening of the compartment defines a back wall. See the perspective of the view shown, for example, in Figure 6.

The tool box further includes sliding plates at gang bars 18. The gang bars may be considered to be sliding plates since the term "sliding" is broad enough to not only define movement with contact, but also gliding/non-contact movement. The

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reference further discloses plural gang bars/sliding plates, wherein a gang bar/sliding plate will be provided on each side of the holders (col. 3, lines 63-67).

The gang bars/sliding plates may be pivotally attached to the ends of the receiving members at a location that is rearwardly of the pivot connection between the receiving members and the wall, as indicated in Figures 9 and 10 of the reference. Thus the sliding plates may be connected at a rear side of the receiving member, and the connection between the receiving member and the wall may be at a front side of the receiving member.

Regarding the limitation calling for an actuating member, one of the receiving members 10 of Vasudeva may be considered to be an actuating member since it is capable of being actuated, such as in a manner shown in Figure 3 or 5.

Regarding claim 6, which calls for the walls to include apertures and the ends of the receiving members to include stubs, Figure 2 of Vasudeva shows such structure.

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.



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14. Claims 1 and 8-16 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over Howard (4,531,646) in view of Resendez, Jr (4,660,902). The reference of Howard discloses a product display rack with tiltable tray and insert assemblies 20,32. The rack frame 12 includes a back/rear wall 13 and side members/walls 14,15. The side walls may be considered to further include members 26. A header assembly 16 defines a top, and the base 18 defines a bottom. This combination defines a box.

The box of Howard is inherently capable of holding tools of appropriate size, and such a capability meets the limitation, tool box" claimed by Applicant.

Insofar as claimed by Applicant, one of the walls 14,26 or 15,26 may be considered to define a separating board inasmuch as it would separate the interior of the frame from the exterior of the frame. The portion 26 of the separating board is at a lesser distance from the other wall than is the remainder of the separating board.

The tray assemblies 20,32 define receiving members since they include channeled recesses between partitions 31 for receiving articles or packages therein. Opposite ends of the front portions of said receiving members 20,32 are pivotally attached to the members 26 which are fixed on the side walls 14,15.

Defining sliding plates are the members 24 which slide with respect to the side walls 14,15. The opposite ends of the rear portions of said receiving members are pivotally attached to said sliding plates 24. The attachment interconnects the

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rear portions so that the receiving members will simultaneously tilt and so that actuation of one receiving member 20,32 will automatically result in similar movement from other receiving members (col. 2, lines 62-67). Accordingly, any of the receiving members can be also defined as an actuating member.

Further regarding Applicant's claim 14 which calls for one of the walls to be located between side walls, wall 18 and the header 16 may be considered to define side walls insofar as Applicant has claimed. The walls 14 and 15 are disposed between said side walls 16,18.

Although the reference of Howard does not disclose a pivotal covering means, the reference of Resendez, Jr, at 47, at Fig. 1, and at col. 1, line 25 through col. 2, line 3, suggests that a display case with shelves may be provided with a hinged transparent, lockable front door/covering means for the purpose of providing selective security or access for the displayed merchandise on the shelves. To appropriately mount the door, the side walls (22,24) of the case extend forward of the display shelves (33). Accordingly, it would have been obvious in view of Resendez, Jr to have provided the display rack of Howard with a pivotable covering means/door in front of the shelves/tray assemblies 20 and with appropriate rack side walls in the manner of Resendez, Jr for mounting the door, for the purpose of providing selective security for the displayed goods on the shelves.

15. Claims 3-5 would be allowable if an appropriate supplemental reissue declaration is filed so as to overcome the

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rejection(s) under 35 U.S.C. 251 set forth in this Office action and if the claims are amended to include all of the limitations of the base claim and any intervening claims, so as not to depend from a rejected claim.

Regarding claim 3, which calls for two legs to extend from the side plates of the cover and be pivotally connected with the side walls (of the base portion), the reference of Vasudeva includes such structure in the embodiments of Figures 17A,17B, **but these embodiments have an effective reference date of August 6, 1998**, which is after the filing date April 10, 1998 of Wei. Such structure was not disclosed in the parent application 08/979,879 of Vasudeva or in the provisional applications 60/054,935 or 60/077,470. While it is asserted that *leg connections on covers such as claimed* are known, there would have been no prior art suggestion to have modified the subject matter of the various reference of Vasudeva or the reference of Howard to result in the combination that is set forth in claim 3.

16. Applicant's arguments with respect to claims 1 and 6-16 are have been considered but are moot in view of the new ground(s) of rejection.

17. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is

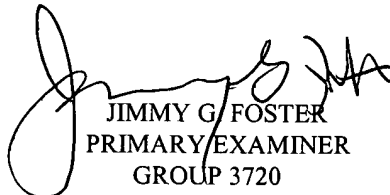
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reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

18. For contacting the PTO by phone, the following contact numbers may be used:

For tracking of papers and association of papers with cases --  
Customer Service. . . (703)306-5648  
For matters regarding examination -- Examiner:  
Jim Foster . . . . . (703)308-1505  
For faxing of correspondence:  
Draft amendments only-(703)308-7769  
(Examiner should be notified of fax)  
Formal correspondence-(703)305-3579 or 305-3580  
RIGHT FAX-Before Final . . (703) 872-9302  
-After Final . . . (703) 872-9303  
(The examiner ordinarily will not retrieve formal correspondence)  
For petitions:  
Before the Examiner . (703)308-1505  
Before the Group Director . (703)308-3872  
Other petitions . . . (703)305-9282

  
JIMMY G FOSTER  
PRIMARY EXAMINER  
GROUP 3720

JGF  
March 24, 2003